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1001 G Street, N.W., Suite 1100
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In re Application of :
GROSS, Yossi *et al* :
U.S. Application No.: 10/522,615 :
PCT No.: PCT/IL2003/00631 :
Int. Filing Date: 31 July 2003 :
Priority Date: 31 July 2002 :
Attorney Docket No.: 001205.00002 :
For: DELIVERING COMPOUNDS TO THE :
BRAIN BY MODIFYING PROPERTIES :
OF THE BBB AND CEREBRAL :
CIRCULATION :

DECISION

This decision is in response to applicants' "Petition Under 37 C.F.R. § 1.47(a)" filed 06 February 2006.

BACKGROUND

On 05 July 2005, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and a \$65.00 surcharge fee was required. Applicants were given two months to respond with extensions of time available.

On 06 February 2006, applicants filed the instant petition which was accompanied by, *inter alia*, a declaration signed by two of the three named inventors; a declaration of Eliana Koren ("Decl."); a copy of a postal receipt in Hebrew; a five-month extension and fee; the surcharge fee; and authorization to charge the petition fee and any additional fee to counsel's Deposit Account No. 19-0733.

DISCUSSION

A petition under 37 CFR 1.47(a) requires: (1) the petition fee; (2) factual proof that the missing joint inventor cannot be located or refuses to cooperate; (3) a statement of the last known address of the nonsigning joint inventor; (4) and an oath or declaration executed by the signing joint inventor on their behalf and on behalf of the nonsigning joint inventor.

Concerning item (1), the \$200.00 petition fee has been charged to counsel's Deposit Account as authorized.

With regards to item (3), the last known address of Benny Shalia is listed as:

44, Ramat Hagolan st.
Jerusalem, Israel

Concerning item (4), the 37 CFR 1.47(a) applicant submitted a declaration signed by two of the three co-inventors on their own behalf and on behalf of the nonsigning joint inventor. This declaration meets the requirements of section 409.03(a) and is in compliance with 37 CFR 1.497(a) and (b).

Items (1), (3) and (4) of 37 CFR 1.47(a) are satisfied.

Regarding item (2), the 37 CFR 1.47(a) applicant claims that the nonsigning "is unavailable or has refused to sign the declaration." Petitioners included a declaration by Eliana Koren who claims that she "sent a certified letter . . . to Dr. Benny Shalita enclosing a copy of the declaration and assignment to Dr. Shalita's last known address." Decl. at ¶ 3. A copy of a document in Hebrew was also submitted without an accompanying English translation.

The analysis for item (2) will be conducted for both inventor unavailability and refusal to cooperate. Section 409.03(d) of the MPEP states, in part:

INVENTOR CANNOT BE REACHED

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made . . .

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included in the statement of facts. It is important that the statement contain facts as opposed to conclusions.

The 37 CFR 1.47(a) applicant failed to provide any evidence that a search was conducted to locate the nonsigning inventor. The 37 CFR 1.47(a) applicant did not even attempt to contact Dr. Shalita via telephone. Moreover, no documentary evidence

was provided other than a copy of a document in a foreign language. The Office does not accept foreign language documents as evidence without an accompanying English translation. Thus, petitioners failed to meet the requirements showing that the nonsigning inventor could not be found.

Section 409.03(d) of the MPEP also states, in part:

REFUSAL TO JOIN

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney . . . It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956).

Petitioners failed to provide any evidence showing that a complete copy of the subject application was received by the nonsigning inventor. The declaration by Eliana Koren states only that a copy of a declaration and assignment were sent to the last known address of Dr. Shalita. As such, petitioners failed to meet the requirements showing that the nonsigning inventor refused to cooperate.

For these reasons, item (2) is not yet satisfied.

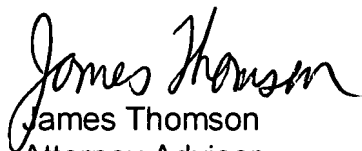
CONCLUSION

Applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. No additional petition fee is required.

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia

22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

A handwritten signature in black ink, appearing to read "James Thomson". The signature is written in a cursive, flowing style.

James Thomson
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